



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 040388/0110

In re patent application of

Jean-Francois BACH *et al.*

Serial No. 08/986,568

Group Art Unit: 1644

Filed: December 5, 1997

Examiner: D. Saunders

For: *METHOD FOR TREATING ESTABLISHED SPONTANEOUS
AUTO-IMMUNE DISEASES IN MAMMALS*

RECEIVED

DEC 26 2002

PETITION UNDER 37 C.F.R. § 1.181 TO INVOKE THE SUPERVISORY
AUTHORITY OF THE COMMISSIONER

TECH CENTER 1600/2900

Group Director of Group 1600
Washington, D.C. 20231

RECEIVED

DEC 12 2002

Sir:

OFFICE OF PETITIONS

This communication relates to an Office Action mailed on June 11, 2002, in the above-captioned case. As discussed below, the examiner has erroneously reopened prosecution after a decision by the board. Moreover, the examiner's rejections exemplify the type of piecemeal examination prohibited by the USPTO.

I. The examiner has erroneously reopened prosecution after a decision by the Board of Patent Appeals and Interferences

Applicants have actively prosecuted the instant case for the last five years. After Examiner VanderVegt, who originally handled the case, refused to recognize the erroneous nature of his rejections, applicants appealed their case to the Board of Patent Appeals and Interferences. The Board reversed an obviousness rejection of all appealed claims, based on the combination of *Racadot et al.*, *Gussow et al.* and *Chatenoud et al.*, and, under 37 C.F.R. §1.196(b), enunciated a new lack-of-novelty rejection of claim 1, based upon *Chatenoud et al.* Accordingly, the Board returned only an anticipation rejection of claim 1 to Examiner Saunders, who had taken over the case by that time.¹

¹ The Board decided that claims 2, 4-7, 9-13 and 16-18 "fall together with claim 1" because appellants had "grouped the claims as standing or falling together." Decision at page 7, lines 1-3. Because the pending rejection was raised for the first time by the Board, however, applicants could not have grouped the claims in light of the new grounds for rejection. A request for clarification was filed at the Board on March 7, 2002.

While disagreeing with the Board's inherency theory of anticipation, applicants opted to advance prosecution by qualifying claim 1 to recite methods of treating "humans," rather than "mammals." As Examiner Saunders acknowledged, this revision of claim 1 overcame the Board's only rejection.² Thus, the prosecution of the instant application should have reached a denouement.

In violation of 37 C.F.R. §§ 1.196 and 1.198, however, the examiner reopened prosecution. Without authority, the examiner issued an indefiniteness rejection under 35 U.S.C. §112, ¶2, thereby resurrecting a previously resolved issue. In particular, the examiner now questions the use of the term "anti-CD3 active compounds," which was specifically approved by the examiner's predecessor. Similarly, the present examiner issued a new enablement rejection under 35 U.S.C. §112, ¶1. Finally, the examiner levied two obviousness rejections based on an alleged *inherent* disclosure in Chatenoud *et al.*, thereby managing to simultaneously violate the law both procedurally and substantively.

Simply put, the examiner lacked the authority to issue the pending rejections.³ According to the MPEP "a new ground of rejection raised by the Board [under 37 C.F.R. 1.96(b)] does not reopen the prosecution except as to that subject matter to which the new rejection was applied."⁴ Accordingly, applicants request that the Group Director invoke his supervisory authority and overrule the rejections.

II. The instant Action epitomizes piecemeal examination

According to the Patent Office's examination guidelines, examiners are prohibited from conducting piecemeal examination.⁵ That is, all "[m]ajor technical rejections . . . should be applied where appropriate even though there may be a seemingly sufficient rejection on the basis of prior art."⁶ In promulgating the rule, the Patent Office recognized the necessity to streamline the examination process so as to limit prosecution costs and to preserve patent term.

² Office Action dated June 11, 2002, page 3, ¶3.

³ See 37 C.F.R. §§ 1.196 and 1.198.

⁴ MPEP §1214.01 (Aug. 2001), page 1200-34.

⁵ See MPEP §707(g) (Aug. 2001), page 700-100.

⁶ *Id.*

Yet the examiner in the instant case has issued a new enablement rejection after five years of prosecution and an appeal to the Board. This is exactly the type of conduct barred by the guidelines.

Accordingly, Applicants request the Group Director to invoke his supervisory authority and overrule the rejection.

10 December 2002

Date

Respectfully submitted,

Bria McClesli

Reg No. 48,571

For

Stephen A. Bent

Reg. No. 29,768

FOLEY & LARDNER
3000 K Street, N.W.
Suite 500
Washington, D. C. 20007-5109
(202) 672-5300